AMENDMENT UNDER 37 C.F.R. § 1.116 Attorney Docket No.: Q92480

Appln. No.: 10/562,736

REMARKS

In the present Amendment, claim 1 has been amended to delete general formula (11).

New claims 54 and 55, which are made by deleting formula (3), and formulas (3) and (11), respectively, from previous claim 1, have been added. Claim 17 has been amended to change "according to claim 1 or 5" to --according to any one of claims 1, 5, 54, and 55--. No new matter has been added, and entry of the Amendment to place the present application in condition for allowance is respectfully requested.

Upon entry of the Amendment, Claims 1 and 5-55 will be pending, of which claims 20-50 are withdrawn from consideration.

Claims 1, 6, 8-19 and 51-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiuchi et al (WO 01/42360 or US 6,730,402 or US 2003/0152776, equivalent documents).

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiuchi et al in view of Nakamura et al (US 6,645,630).

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiuchi et al in view of Takada et al (JP 2002-241590).

Applicants submit that the above three rejections should be withdrawn because Kiuchi et al, Nakamura et al and Takada et al do not disclose or render obvious the present invention, either alone or in combination.

None of the cited references (Kiuchi et al, Nakamura et al and Takada et al) teach the subject matter of the amended claim 1 including a combination of an epoxy resin (A) and an epoxy resin curing agent (B) in which:

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the epoxy resin curing agent (B) includes a phenol resin (F) represented by one of general formulas (3) to (8) containing at least one of structural units X and Y represented by general formulas (1) and (2), respectively; and

the epoxy resin (A) includes an epoxy compound (G) represented by one of general formulas (12) to (16) and containing at least one of structural units X' and Y' represented by general formulas (9) and (10), respectively.

Accordingly, the present claims are not obvious and are patentable over Kiuchi et al, Nakamura et al, and Takada et al, either alone or in combination. Reconsideration and withdrawal of all the §103(a) rejections are respectfully requested.

Claims 1, 6, 8-19 and 51-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combined limitations of claims 27-29, 36-39, 58-66 and 69 of Kiuchi et al (US 6,730,402).

Claim 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Kiuchi et al in view of Nakamura et al.

Claim 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Kiuchi et al in view of Takada et al.

Applicants submit that the above three double patenting rejections should be withdrawn because the present claims are not obvious over the claims of Kiuchi et al.

As discussed above with respect to the § 103 rejections, Kiuchi et al does not teach or suggest the claimed epoxy resin composition including a combination of an epoxy resin (A) and an epoxy resin curing agent (B) in which:

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the epoxy resin curing agent (B) includes a phenol resin (F) represented by one of general formulas (3) to (8) containing at least one of structural units X and Y represented by general formulas (1) and (2), respectively; and

the epoxy resin (A) includes an epoxy compound (G) represented by one of general formulas (12) to (16) and containing at least one of structural units X' and Y' represented by general formulas (9) and (10), respectively.

Accordingly, the present claims are not obvious and are patentable over the claims of

Nakamura et al and Takada et al do not make up for the deficiencies of Kiuchi et al.

In view of the above, reconsideration and withdrawal of the double patenting rejections are respectfully requested.

New claims 54 and 55 are patentable over the cited references for the following reasons.

None of the cited references disclose the subject matter of claim 54 including a combination of an epoxy resin (A) and an epoxy resin curing agent (B) in which:

the epoxy resin curing agent (B) includes a phenol resin (F) represented by one of general formulas(4) to (8) containing at least one of structural units X and Y represented by general formulas (1) and (2), respectively; and

the epoxy resin (A) includes an epoxy compound (G) represented by one of general formulas (11) to (16) and containing at least one of structural units X' and Y' represented by general formulas (9) and (10), respectively.

Also, none of the cited references disclose the subject matter of claim 55 including a combination of an epoxy resin (A) and an epoxy resin curing agent (B) in which:

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the epoxy resin curing agent (B) includes a phenol resin (F) represented by one of general

 $formulas (4) \ to \ (8) \ containing \ at \ least \ one \ of \ structural \ units \ X \ and \ Y \ represented \ by \ general$

formulas (1) and (2), respectively; and

the epoxy resin (A) includes an epoxy compound (G) represented by one of general

formulas (12) to (16) and containing at least one of structural units X' and Y' represented by

general formulas (9) and (10), respectively.

Allowance is respectfully requested. If any points remain in issue which the Examiner

feels may be best resolved through a personal or telephone interview, the Examiner is kindly

requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted

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